

Appl. No. 10/730,438  
Atty. Docket No. CM2713Q  
Amdt. dated November 28, 2006  
Reply to Office Action of August 29, 2006  
Customer No. 27752

### REMARKS

#### Claim Status

Claims 1 – 9 are pending in the present application. No additional claims fee is believed to be due.

#### Rejection Under 35 USC §102 Over Tao

Claims 1 and 3 – 6 have been rejected under 35 U.S.C. §102(b) as being anticipated by Tao, et al., (WO 99/32164, hereafter “Tao”). Applicant respectfully traverses the rejection.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). McCormack does not teach all of the claim elements of claims 1 and 3 - 6.

#### The Office Action states

Tao discloses film comprising non-woven material and microporous film (page 1, lines 28 – 30, page 11, lines 27 – 31) used for diaper 50 back sheet 52 (page 10, lines 1 – 3) having single or multiple ornamental discernible printed design graphics 20 via flexographic and gravure printing processes (page 8, lines 14 – 16, figures 1 and 4) and said film composite having an “L-value” of 93.46, “a value” of -0.24 and “b-value” of 0.35 (page 3 lines 2 – 9, page 8, lines 19 – 21, page 13, lines 9 – 13) . . . .

The Office Action, page 2, last paragraph. Applicant respectfully asserts that Tao does not teach each and every element of claim 1. Specifically, Tao does not teach a disposable article having a backsheet with an “L hunter value” from 10 to 75.

Tao does not teach each and every element of claim 1, and thus, does not teach each and every element of claims 3 – 6, which depend from claim 1. Accordingly, Applicant respectfully requests that the rejection under 35 U.S.C. § 102(b) be reconsidered and withdrawn.

#### Rejection Under 35 USC §102/§103 Over Tao

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Claims 2 and 7 are rejected under 35 U.S.C. 102(b) as anticipated by, or in the alternative, under 35 U.S.C. §103(a) as obvious over Tao, *et al.* Applicant respectfully traverses the rejection.

For the reasons stated above with respect to claim 1, Applicant asserts that Tao also does not teach or suggest each and every element of claim 2 or 7, which depend from claim 1.

Even if Tao did teach or suggest a disposable article having a backsheet with an "L hunter value" from 10 to 75, as is recited in claim 1 of the present application, it is Applicant's position that Tao still would not teach or suggest each and every element of claim 2 or 7.

The Office Action states that "Tao **inherently** discloses the opacity values and distance between a rear core end edge and rear end edge since the disposable absorbent article is disclosed as discussed above with respect to claim 1." The Office Action, page 3, second full paragraph (emphasis added).

"To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that certain thing may result from a given set of circumstances is not sufficient.'"

MPEP §2163.07(a) quoting *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

With regard to claim 2, it is Applicant's position that the particular portions of Tao cited by the Office Action do not "make clear that the missing descriptive matter is necessarily present." The portions of Tao cited by the Office Action may disclose a film comprising non-woven material and a microporous film used for a diaper backsheet. Tao also discloses that the disposable absorbent article may include with a backsheet film having calcium carbonate (Tao, page 3, lines 4 - 9). However, Applicant asserts that merely because Tao may disclose such a backsheet does not necessarily mean that the backsheet has the opacity properties recited in the claim 2 of the present application. One of ordinary skill in the art would appreciate that a backsheet comprising a non-woven material, a microporous film and calcium carbonate may include a variety of

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configurations and have a variety of opacities. Absent any disclosure in Tao that teaches or suggests a particular configuration having an opacity as is disclosed in claim 2 of the present application, the Office has not shown that elements of claim 2 are inherent in the film of Tao. On the contrary, Tao discloses that “[t]he calcium carbonate is used to provide microporosity.” Tao, page 4, line 14. Thus, there is no showing that one of ordinary skill in the art would necessarily recognize the film of Tao to have an opacity of from about 55% to about 100% in the areas outside the printed ornamental designs, as is recited in claim 2 of the present application.

Likewise, with regard to claim 7, it is Applicant’s position that there has been no showing by the Office that the particular portions cited in Tao necessarily contain all the elements of claim 7. Tao may disclose a disposable absorbent article, but one of ordinary skill in the art would not necessarily recognize that the disposable article comprises a rear waist edge and a rear core end edge, wherein the distance between said rear end edge and said rear core end edge comprises at least about 40 mm.

Alternatively, the Office states “[o]pacity is a result-effective variable since it is a result of the type of materials used.” The Office Action, page 3, last paragraph. The law is well settled that “[a] particular parameter must first be recognized as a result-effective variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation.” MPEP §2144.05(II)(B) citing *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977). In the case of *In re Antonie*, the prior art did not recognize a particular parameter and therefore the parameter optimized was not recognized in the art to be a result-effective variable. *Id.* Likewise in the instant case, Tao does not recognize the parameter of opacity and thus, opacity cannot be said to be a result-effective variable.

With regard to claim 7, the Office states “[t]he distance between rear waist edge and absorbent core end edge is a result effective variable since it is a result of the diaper overall dimension and absorbent core dimensions.” The Office Action, page 3, last paragraph. The remarks made above with regard to opacity are equally applicable to claim 7. Specifically, that Tao does not recognize the parameter of distance between the

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rear waist edge and absorbent core end edge. Therefore, the Office has failed to establish that such a parameter is a result-effective variable.

In light of the above remarks, Applicant asserts that Tao does not teach or suggest each and every element of claim 2 or 7. Accordingly, Applicant respectfully requests that the rejection of claims 2 and 7 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

Rejection Under 35 USC §103(a) Over Tao in view of Schleinz et al.

Claims 8 – 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tao in view of Schleinz, *et al.*, (U.S. Pat. No. 5,612,188, hereafter “Schleinz”). Applicant respectfully traverses the rejection.

The Office Action states “Tao does not expressly disclose a half-toning printing process in which one of the surfaces . . . is covered with an opaque or transparent ink while a second area is covered with the same ink.” The Office Action, page 4, first full paragraph. The Office looks to Schleinz for the missing disclosure.

Even assuming, *arguendo*, that Schleinz provides the disclosure for which it is cited, Schleinz still does not provide the missing disclosure with regard to the “L hunter value” discussed above. Specifically, Applicant is unable to find any disclosure of an “L hunter value” of from 10 to 75 in Schleinz.

Thus, Tao in combination with Schleinz still does not teach or suggest each and every element of claim 8 or 9. Accordingly, Applicant respectfully requests that the rejection of claims 8 and 9 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

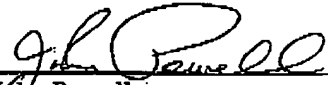
Conclusion

This amendment represents an earnest effort to place the application in proper form and to distinguish the invention as now claimed from the applied references. Applicant respectfully requests that the rejection of the claims be reconsidered in light of the claim amendments and arguments set forth herein and that claims 1 – 9 be allowed. Early and favorable action in the case is respectfully requested.

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